

### **REMARKS**

Claims 1-25 are pending. Claims 14, 15, 17-21, 23 and 24 have been withdrawn. No claims have been amended. Claims 1-13 and 16 have been allowed. No new claims have been added, and no claims have been cancelled. Accordingly, claims 1-13, 16, 22 and 25 are currently under consideration. The Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Applicants respectfully request reconsideration of all pending claims.

### **Allowable Claims**

The Applicants thanks the Examiner for indicating that claims 1-13 and 16 are allowable. In view of the comments below, the Applicants urge the Examiner to allow all of the pending claims.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 22 and 25 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. 2002/0048112 to Chu et al. (“Chu”) in view of U.S. 2002/0063559 to Richter (“Richter”).

According to the Office Action:

“Regarding claim 22, Chu et al. discloses a method to determine defects on a magnetic printed disk comprising: ... taking readings and identifying servo bursts on the magnetic medium, *which occur at particular polar coordinates* (See Chu et al., paragraphs 0039 and 0040, it is noted that every servo burst has a specific track radius and location on track, thus, has a specific polar coordinate), ...” Office Action of July 21, 2005, page 2, emphasis added.

Applicants respectfully disagree. Chu does not teach or suggest taking magnetic readings on the disc *at selected* polar coordinate locations on the disc, as recited by claims 22 and 25. Furthermore, neither Chu nor the combination of Chu and Richter teach or suggest generating a signal output from the magnetic readings *correlated with the selected polar coordinates*, as recited by claims 22 and 25.

First, Chu does not take readings at *selected* polar coordinate locations on the disc. In fact, Chu is indifferent to the actual polar coordinates of the burst signals. See Chu, paragraphs [0037] to [0039]. Chu does not select polar coordinates on the disc to take measurements. Instead, Chu scans the disk, one cylinder at a time, looking for defects. See Chu, paragraph [0037] (“The scan process 400 may continue until all of the heads in all of the cylinders have been read, or a preset number of heads and cylinders may be read.”) and paragraph [0039] (“one aspect of the present invention is to scan for and manage real servo defects”). The difference is akin to reading an entire book, or reading selected passages.

Second, Chu does not generate a signal output from the readings taken at selected polar coordinates that are correlated with the selected polar coordinates. Chu scans the disk, and measures the magnitude of servo burst signals in individual sectors, ignoring the locations (polar coordinates) of servo signals within that sector. Chu’s method sums the intensities of burst signals within the entire sector. Thus, Chu does not correlate the magnetic readings with the polar coordinates of the burst signals, because Chu is concerned only with creating a single value that can be compared to a reference value to detect if a particular sector is flawed. See, e.g., Chu at [0044] (“Continuing to refer to FIGS. 6A and 6B, at block 605 the process 600 proceeds with measuring the magnitude of the servo bit burst signals for the sector i. This value is stored in variable Burst\_Sum.”).

In contrast, claims 22 and 25 recite a method in which signals are taken from a disc at *selected* polar coordinates, and these polar coordinates are coordinated with the signal generated from the magnetic reading taken at the selected polar coordinates. Neither Chu nor Richter nor the combination of Chu and Richter teach or suggest these steps. Instead, Richter teaches a method for measuring signal decay in which a control track and a track of interest are located on one track. See Richter, Abstract.

Thus, the Office Action has failed to set forth a *prima facie* case of obviousness, at least because the references cited by the Office Action fail to teach every limitation of the Applicants’ pending claims. If even one of the elements required to set forth a *prima facie* case of obviousness

is not shown, then the obviousness rejection should be withdrawn. MPEP §2142. The rejection of claims 22 and 25 under 35 U.S.C. §103 over the combination of Chu and Richter cannot stand.

Applicants respectfully request withdrawal of the 35 U.S.C. §103 rejection of claims 22 and 25.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 146712013300. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 19, 2005

Respectfully submitted,

By



Rick Shoop

Registration No.: 45,763

MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5804